

Application No. 09/435,256

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REMARKS

In response to the Office Action of March 24, 2004, Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims as amended remain allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

Claim 1 has been amended.

In the first Office Action of April 23, 2003, claims 1, 2, and 5 are rejected, and claims 3, 4, 6 and 7 are objected to. Claim 3 is rejected under 35 U.S.C. §112, as being indefinite. Claims 1, 2, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,818,964, to Itoh, in view of U.S. Patent No. 5,666,436, to Eames. Claims 3, 4, 6 and 7 are indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In the second Office Action of October 7, 2003, claims 1, 2, and 5 are rejected, and claims 3, 4, 6 and 7 are objected to. Claims 1, 2, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,818,964, to Itoh, (hereinafter Itoh) in view of U.S. Patent No. 5,907,415, to Yabe, (hereinafter Yabe-1). Claims 3, 4, 6 and 7 are indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this third Office Action of March 24, 2004, claims 8-11 are allowed, claims 1, 2, and 5 are rejected, and claims 3, 4, 6 and 7 are objected to. The Applicants wish to express appreciation for the allowance of claims 8-11.

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Claims 1, 2, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,818,964, to Itoh, (hereinafter Itoh) in view of U.S. Patent No. 6,359,703, to Yabe, (hereinafter Yabe-2). Claims 3, 4, 6 and 7 are indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1, 2, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh, in view of Yabe-2. Itoh discloses a device and method for filtering out the noise generated due to coding of image data signals. The device has a threshold determining unit, a binary index unit, a filter selecting unit, and an adaptive filtering unit. The threshold determining unit divides each pixel of the input image data into two gray levels. The binary indexes defined by the gray level are checked by a window with a prescribed size. If the region in the window is determined to be a homogeneous region, a heterogeneous region, or an impulse noise region, the filter selecting unit selects a filter corresponding to the determined region, and the image data is processed by the selected filter. However, Itoh is entirely concerned with filtering to remove noise in image data and there is no mention, hint, or suggestion, of how any filtering criterion can be applied to the problems of color gamut mapping.

Yabe-2 teaches an image processor includes an input device that inputs image data representing a target image, and a color gamut mapping device that performs a color gamut mapping process. The image processor also includes a color reproduction process device that performs a color reproduction process, and a judgement device that judges whether a monochromatic mode for forming an image on a recording medium is set. A controller controls the color gamut mapping device and the color reproduction device, with the controller inhibiting the color gamut mapping device from

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performing a color mapping process on the input image data when a judgment is made that the monochromatic color mode is set.

Yabe-2 teaches the employment of but one gamut mapping method. Nor does Yabe-2 teach employing the feedback of luminance information as based upon local image activity. As such it is entirely non-analogous and different from the applicant's image adaptive gamut mapping wherein the mapping process is modified as a function of the input data with regards to spatial neighborhoods of pixels. The Yabe gamut mapping method operates only on a single pixel basis and not upon local luminance image activity.

Like Itoh, Yabe also completely misses the central teaching of the Applicants' invention which is that color gamut mapping is most pleasing to the eye when variations in color are preserved within local spatial neighborhoods of pixels in an image. Yabe makes no suggestion of controlling gamut mapping by application of spatial filtering in response to local image activity. Neither Itoh, or Yabe, supplies what the other lacks. They fail to even acknowledge the gamut mapping problem the Applicants teach. They certainly fail to suggest their own combination, and further they fail to teach how one skilled in the art could make anything of use from their combination.

Simply stating, as the Office Action does, that Itoh and Yabe are analogous art because they from the same field of endeavor and therefore obvious to combine, is a classic failure to make out a true prima facie case of obviousness. Unless there is some showing, some objective teaching in either the prior art, or knowledge provided of a rationale generally available to one of ordinary skill in the art, that 'would lead' that individual to combine the relevant teachings of the references, the burden of providing a prima facie case of

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obviousness has not been met. No such showing or objective teaching has been provided. *The burden of providing a prima facie case of obviousness has not been met.*

When determining patentability under §103, the Examiner must consider the invention as a whole, and cannot view each element of the claim separately with respect to the prior art. See, e.g., Jones v. Hardy, ___ F.2d ___, 220 U.S.P.Q. 1021 (BNA) (Fed. Cir. 1984). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention. Uniroyal Inc. v. Rudkin Wiley Corp., ___ F. 2d ___, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F. 2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The only way anyone could reach the Applicants' teaching that color gamut mapping is most pleasing to the eye when variations in color are preserved within local spatial neighborhoods of pixels in an image, from a combination of Itoh and Yabe, is with impermissible hindsight. Indeed, the Examiner appears to have considered various portions of the references cited, in each instance viewing the cited portion in isolation from the context of the entire reference, and combined these isolated portions to arrive at the present invention with the benefit of hindsight. Using hindsight or applying the benefit of the teachings of the present application when determining obviousness, however, is impermissible; the references applied must be reviewed without hindsight, must be reviewed as a whole, and must suggest the desirability of combining the references. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984).

When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the

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combination other than the hindsight gleaned from the invention itself. Uniroyal Inc. v. Rudkin Wiley Corp., ___ F. 2d ___, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). The only reason provided by the Examiner for the combination of Itoh and Eames is that they are from the same field of endeavor which is image processing. "Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

Allowance of claims 1, 2, and 5 is respectfully requested.

Claims 3, 4, 6 and 7 are indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Never-the-less, as claims 3, 4, 6 and 7, depend from claims deemed allowable, they should be allowable as well. Allowance of claims 3, 4, 6 and 7 is respectfully requested.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

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It is respectfully submitted that the present set of claims are patentably distinct over the cited references. In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



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